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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,853	09/04/2003	David Charles Lyons	12929.1122US02	8586
23552	7590	12/13/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			COCKS, JOSIAH C	
			ART UNIT	PAPER NUMBER
			3749	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/656,853	<b>Applicant(s)</b> LYONS ET AL.	
	<b>Examiner</b> Josiah Cocks	<b>Art Unit</b> 3749	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2005 and 05 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/8/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings filed 9/4/2003 and 2/5/2004 are accepted by the examiner. The drawing sheet filed 3/4/2004 appears to be a duplicate of the drawing sheet filed 2/5/2004. However, this sheet 3/4/2004 is not marked as "Replacement sheet" as required 37 CFF 1.121 and accordingly has not been entered.

### ***Claim Objections***

2. Applicant is advised that should claim 11 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,307,801 to Schroeter et al. ("Schroeter").

Schroeter discloses in the specification and Figs. 1-9 an invention identical to that described in applicant's claim 33. In particular note return air plenum (62), surround/front panel (at least casing panels, 20, 22, 24, 26, 28, see col. 3, lines 43-49) with openings (74) (see col. 5, lines 22-34 and Figs. 1, 2, and 4).

5. Claims 1-33 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2004/0011352 to Bachinski et al. ("Bachinski").

Bachinski discloses in the specification and Figs. 1-3 an invention in the same field of endeavor as applicant's invention and as described in applicant's claims 1-33. In particular, Bachinski shows a fireplace (100 or 400) and method forming the fireplace that includes providing a surround (461) for attachment to the fireplace wherein the surround includes first and second side members and includes a opening defined by the top member (see Fig. 3) and placed such that air from vents (46) is directed through the opening. The surround includes a cavity as recited and the portions of the surrounding the opening are considered to be the shield as recited. Activation panel (401) is provided in the cavity and is considered to be an insulating member (note discussion of thermal insulation as applied to similar panel 300, page 2, paragraph [0027]). The surround is molded from compression or vacuum molded materials and contains a ceramic fiber and binder (see page 3, paragraphs [0036] and [0038]).

In regard to claims 6, 7, 27, and 28, the unnumbered portion at the bottom of the surround (461) shown in Fig. 3 is considered to be the access panel as recited.

Bachinski also shows a return air plenum (514) including a vent (460).

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-5, 8-10, 12-15, 17, 18, 20-26, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,409,870 to Duffney ("Duffney") in view of U.S. Patent No. 5,307,801 to Schroeter et al. ("Schroeter").

Duffney discloses in the specification and Figs. 1-29 a decorative surround for a fireplace (see col. 2, line 7) in the same field of endeavor as applicant's invention and similar to that described in applicant's claims 1-5, 8-10, 12-15, 17, 18, 20-26, 29 and 30. In particular, Duffney shows an one-piece molded surround (see Fig. 1) that includes first and second side members

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that define a cavity (see Fig. 4). Duffney further shows that openings (such as 20) may be milled, routed or lazered as desired into the surround (see col. 4, lines 42-57). Duffney also discloses that an insulative filler (30) may be provided in the cavity.

In regard to claims 7 and 21, the walls of openings (20) would function to direct through the openings and are considered to be the shield as recited.

In regard to the recitation that the cavity is in fluid communication with a vent of a fireplace and that the opening is configured to exhaust the collected air, while Duffney discloses use of his decorative casing as a fireplace surround, no fireplace with a vent or heating source is disclosed.

However, Schroeter is cited to show to the general arrangement of a fireplace (10) with vents and a heating source (38). In Schroeter, the fireplace (10) includes a surround (at least casing panels, 20, 22, 24, 26, 28, see col. 3, lines 43-49 and Fig. 1) arranged adjacent a vent of a fireplace (air exhausted from plenum 62). The surround includes opening (74) arranged at the vent to exhaust collected air.

Therefore, the examiner considers that it would be obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the decorative surround of Duffney with the fireplace of Schroeter to desirably provide an artistic accent feature for the front of a fireplace (see Duffney, col. 1, lines 35-40 and col. 2, lines 5-9). In doing so, the surround of Duffney would be arranged such that the cavity (24) would be in communication with the vent of Schroeter. Further, in order to provide the exhaust feature of opening (74) in Schroeter a person of ordinary skill in the art would recognize that similar openings would be provided in Duffney

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as locations adjacent the vents by the milling, routing or lazing procedure disclosed in Duffney (see col. 4, lines 42-57).

9. Claims 6, 7, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffney in view of Schroeter as applied to claims 5 and 27 above, and further in view of U.S. Patent no. 6,026,805 to Burch et al. ("Burch").

Duffney in view of Schroeter disclose all the limitations of claims 6, 7, 27, and 28 except for a removably secured access panel.

Burch discloses a fireplace in the same field of endeavor as applicant's invention. In Burch, a fireplace includes a front panel/surround with a lower opening (60). Access to burner controls (36) are provided through this opening (see Fig. 4). Burch explicitly provides that a removable access panel (39) is provide over this opening to cover the opening the burner controls (see col. 4, lines 5-7). The examiner notes that this arrangement of a lower opening and lower burner controls is substantially identical to that shown in Schroeter (note at least Fig. 7 and control 40). While Schroeter does not appear to discuss a covering for the opening (62, see Fig. 1) which provides access to control (40) the examiner considers that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a removable access panel as taught in Burch over the opening of Schroeter for the purpose of covering the opening after manipulation of the burner controls.

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10. Claims 11, 16, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffney in view of Schroeter as applied to claims 1 and 22 above, and further in view of U.S. Patent No. 3758,317 to Moore ("Moore").

Duffney and Schroeter disclose all the limitations of claims 11, 16, 31, and 32 except that the molded material is a ceramic material with a binder and formed through compression molding. Duffney does however note that the material of the surround may be a variety of materials of any other material preferred (see col. 4, lines 20-23).

Moore teaches an article and method of making the article that is considered analogous to the problem of molding a surround for a fireplace. In Moore, an article that is useful for forming a monolithic structure for use as a facing, other decorative purposes, or for household burners (see col. 8, lines 68-72) is made of a ceramic material that includes a binder (see col. E, lines 10-31). Further, this article is made through vacuum or compression molding (see col. 8, lines 45-48).

Therefore, in regard to claims 11, 16, 31, and 32, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the molded surround of Duffney to be made of the material and in the manner disclosed in Moore to desirably provide a monolithic structure having a desired physical property suitable to function as a facing or burner portion (see Moore, col. 1, lines 187-25 and col. 8, line 68-72).

### ***Double Patenting***

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and



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useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 22-33 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 22-33 of copending Application No. 10/770,348. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re*

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Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 34-51 of U.S. Patent No. 10/770,348. Although the conflicting claims are not identical, they are not patentably distinct from each other because despite some variance in wording the claims of these two applications are claiming the same invention.

### *Conclusion*

15. This action is made non-final. A THREE (3) MONTH shortened statutory period for reply has been set. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

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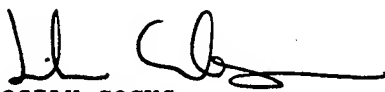
16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Nos. 5,996,575 (Shimek et al.), 6,798,088 (Richmond et al.), 6,953,037 (Rumens), U.S. Patent Application Publication No. 2003/0049575, and UK Patent GB 2 307 808 are included to further show the state of the art concerning fireplace surround arrangements.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Josiah Cocks whose telephone number is (571) 272-4874. The examiner can normally be reached on weekdays from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg, can be reached at (571) 272-4828. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Any questions on access to the Private PAIR system should be directed to the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

jcc  
December 9, 2005

  
JOSIAH COCKS  
PRIMARY EXAMINER  
ART UNIT 3749